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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/500,964

07/08/2004

Keizo Sugasawa

07385.0030

3433

22852

7590

03/31/2008

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER  
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EXAMINER

CHANG, CELIA C

ART UNIT

PAPER NUMBER

1625

MAIL DATE

DELIVERY MODE

03/31/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/500,964	<b>Applicant(s)</b> SUGASAWA ET AL.	
	<b>Examiner</b> Celia Chang	<b>Art Unit</b> 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02/04/08.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 5,7,9-13 and 18-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5,7,9-13 and 18-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

1. Amendment and response filed by applicants dated Feb. 8, 2008 and Dec. 26, 2007 have been entered.

Amendment of Dec. 26, 2007 was replaced by applicants amendments and response dated Feb. 8, 2008.

Claims 1-4, 6, 8, 14-17 have been canceled. Claims 18-47 have been newly added. Claims 5, 7, 9-13, 18-47 are pending.

Two certified translation of the priority documents have been received.

2. The rejections of claims 14-17 are moot in view of the cancellation of the claims.

3. Claim 5 and 37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The scope of the claims as currently amended are very confusing and may contain new matter for which new matter must be removed from the scope.

The term "general" is ambiguous. It is unclear how deviated from the definitions of the Markush elements can it be still considered generally embraced by the formula. If the compounds are those defined by the formula, the term general should be deleted.

It is very confusing about the proviso of indol-2-yl. Please note that the Ar<sup>2</sup> element in claims 5 and 37 have been defined to be optionally substituted phenyl or monocyclic aromatic heterocycle, this scope would not have encompassed any indolyl moiety. Thus, the proviso makes the scope unclear as to what is and is not included.

Further, in claim 5, the R4 moiety has been limited to formula II, therefore, the condition of R4 being formula II in the definition of Ar<sup>2</sup> what it cannot be *is always enforced*. It is very confusing as to what is the scope of the claims.

It is unclear whether claim 37 is within the scope of claim 5 or contains new matter because in claim 37, the phenyl or monocyclic aromatic heterocycles are optionally substituted without limitation while the Ar<sup>2</sup> when R4 is formula II must be substituted with one or more

groups selected from lower alkyl, -CO-lower alkyl, -COO-loweralkyl, -OH, -O-lower alkyl, -OCO-lower alkyl, and halogen.

It is recommended that the scope of the claims be clearly defined with explicit antecedent basis pointed out from the specification.

3. The rejection of claims 5-11 (currently 5, 7, 9-11) under 35 USC 102(a) over Muto et al. CA137 corresponding to published WO 02/049632 is maintained for reason of record.

Please note that, it is noted that in the two translations of the priority documents, the Markush scope of the instant claims was not embraced since elements  $R^{20}$ ,  $R^{21}$ ,  $R^{22}$ ,  $R^{23}$ ,  $R^{26}$ ,  $R^{27}$ , or  $R^{28}$ , are not found and the scope of these elements are not consistent with the definition of the priority documents as  $R^3$ - $R^6$ .

Therefore, the benefit of priority date cannot be granted and the rejection is proper.

4. The rejection of claims 5-17 under 35 USC 102(e), (f) or (g) over US 2004/0077697 which is now applicable to the pending claims 5, 7, 9-13, 18-47, and is maintained for reason of record.

Please note that the pregrant publication contains an anticipatory compound as delineated by CAS. The publication US 2004/0077697 has a *filing* date of Jan. 31, 2002 which is prior to the instant filing date, thus, a 102(e) reference. It is now noted that the corresponding application SN 10/470,917 (prosecution of US 2004/0077697) has been abandoned.

Abandoning a claim to the same invention by SN 10/470,917 will resolve the issues under 35 USC 102(e) or (g) since it will not be patented, but it does not resolve the 102(f) issue. Applicants' attention is drawn to that 102(f) requires evidence of different inventorship owning the same invention which evidence does not have any date requirement. Also, the US law issues patents to the "first" to invent, therefore, who is the *true and first* inventor of the currently amended scope must be clearly identified and the inventorship be consistent with such identification. It was clearly advised in the previous office action that MPEP §2300 stated that the assignee is *required* to make it of record by stating which entity is the first inventor of the subject matter upon presentation of such evidence.

**5. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**6.** Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celia Chang, Ph. D. whose telephone number is 571-272-0679. The examiner can normally be reached on Monday through Thursday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet L. Andres, Ph. D., can be reached on 571-272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*OACS/Chang*  
*Mar. 26, 2008*

*/Celia Chang/*  
*Primary Examiner*  
*Art Unit 1625*